

III. REMARKS

The Examiner's Office Action is in response to the Applicants' Appeal Brief. The Examiner withdrew the previous rejections but now asserts, what the Examiner considers to be, "new" rejections. Applicants appreciate the Examiner's allowance of claims 58-70 and 95-118.

Applicants respectfully traverse the Examiner's rejection of claims 1-3, 11, 13, 15-23, 37, 38, 42, 43 and 45-46 under 35 U.S.C. § 102(b) as being anticipated by *Dawson*, U.S. Patent No. 5,553,160. In particular, Applicants note that prior to Applicants' Appeal Brief, the Examiner had already cited the *Dawson* patent but nonetheless allowed claims 1-3, 5-25, 37, 38 and 40-46. *See, e.g.*, the Examiner's Office Actions dated August 5, 2002 and August 5, 2003. Thus, Applicants submit that as to these claims, the Examiner has not asserted new grounds for rejection but instead has merely reasserted positions that the Examiner previously conceded were not an appropriate basis for rejecting these claims. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections.

The Examiner has also rejected claims 14, 26, 27, 30 and 44 under 35 U.S.C. § 103(a) as being unpatentable over *Dawson* in view of *Oka*, JP 405204747A, which is newly cited prior art. Again, claims 14 and 44 were previously allowed, and the Examiner has provided no basis for why this previous allowance is being withdrawn.

Applicants also respectfully submit that the Examiner has not met the Examiner's burden of factually supporting the alleged motivation to combine *Dawson* and *Oka*. It is the Examiner's burden to factually support any *prima facie* conclusion of obviousness. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the prior art. The preferred evidence to be offered by the Examiner is an express teaching to modify/combine which is set forth within objectively verifiable sources of prior art. *See* MPEP §§ 2141-2144. In this case, the Examiner has not cited to any express teachings

within the *Dawson* and *Oka* references which support a motivation to combine these references to achieve Applicants' claimed invention.

The Examiner also rejected claims 5-10, 31-36, 40-41 and 119-121 under 35 U.S.C. § 103(a) as being unpatentable over *Dawson* in view of *Tsang*, U.S. Patent No. 5,961,617. Again, claims 5-10 and 40-41 were previously allowed, and the Examiner has provided no basis for why this previous allowance is being withdrawn.

Applicants also respectfully submit that the Examiner again has not met the Examiner's burden of factually supporting the alleged motivation to combine *Dawson* and *Tsang*. It is the Examiner's burden to factually support any *prima facie* conclusion of obviousness. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the prior art. The preferred evidence to be offered by the Examiner is an express teaching to modify/combine which is set forth within objectively verifiable sources of prior art. See MPEP §§ 2141-2144. In this case, the Examiner has not cited to any express teachings within the *Dawson* and *Tsang* references which support a motivation to combine these references to achieve Applicants' claimed invention.

Applicants also note in particular that the Examiner has not cited to any teachings in *Tsang* wherein "the compression mode" is determined based on a particular factor such as destination address, type of data, or requesting agent, as set forth in the aforementioned claims rejected by the Examiner. Dependent claim 122 should be allowed at least for the same reason that claim 119 is allowed.

Applicants further note that claims 28 and 29, rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oka* in view of *Dawson* and further in view of *Tsang*, should be allowed at least for the same reasons set forth above.

As to claim 12, the Examiner rejected it under 35 U.S.C. § 103(a) as being unpatentable over *Dawson* in view of *Gentile*, U.S. Patent No. 5,539,865. Again, claim 12 was previously allowed, and the Examiner has provided no basis for why this previous allowance is being withdrawn.

Applicants also respectfully submit that the Examiner has not met the Examiner's burden of factually supporting the alleged motivation to combine *Dawson* and *Gentile*. It is the Examiner's burden to factually support any *prima facie* conclusion of obviousness. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the prior art. The preferred evidence to be offered by the Examiner is an express teaching to modify/combine which is set forth within objectively verifiable sources of prior art. *See* MPEP §§ 2141-2144. In this case, the Examiner has not cited to any express teachings within the *Dawson* and *Gentile* references which support a motivation to combine these references to achieve Applicants' claimed invention.

Applicants also respectfully traverse the Examiner's suggestion that *Gentile* teaches selecting a lossless or lossy compression mode based on whether data is application data or video/graphics data. The Examiner has not cited to any such teachings. *Gentile* merely teaches that "different compression schemes have been found to be preferable for the different representation types of text, graphics, and images." *See* Col. 5, lines 11-24.

IV. CONCLUSION

In view of the amendments and remarks set forth herein, this application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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CERTIFICATION UNDER 37 C.F.R. § 1.8

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